

REMARKS

I. CLAIMS OBJECTIONS

Claims 70 and 72 stand objected to because they allegedly fail to set forth further structural limitations from the claims from which they depend. Claims 70 and 72 recite that the volumetric composite image *has a characteristic that allows the cancerous tissue to be identified*. Since a characteristic of an image describes a feature of an image, it is a structural limitation. Also, because such limitation further limits the claims (note that their respective base claims do not require that the image has such characteristic), Applicant respectfully requests that the claim objections be withdrawn.

II. CLAIMS REJECTIONS UNDER 35 U.S.C. § 102

Claims 29, 32-33, 36-37, 40, 43, 45-47, 66-67, and 72 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Ogawa (U.S. Patent No. 6,278,760). Applicant respectfully notes that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 29 recites that a bodily region includes *a contrast agent* (Emphasis Added). As noted in the Office Action, Ogawa does not disclose a contrast agent. Thus, Applicant respectfully submits that the prima facie case for the § 102 rejection has not been established, and requests that the § 102 rejection be withdrawn.

III. CLAIMS REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-2, 4-7, 10-14, 17-28, 30-31, 38-39, 44, 56-59, and 61-65 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ogawa in view of Hughes et al. (U.S. Patent No. 4,432,370).

Claim 1 recites introducing a *contrast agent* into the body, generating a first set of image data using radiation at a first energy level after the contrast agent is introduced into the body, generating a second set of image data using radiation at a second energy level after the contrast agent is introduced into the body, and creating a *volumetric composite image* using the first and the second sets of image data (Emphasis Added). Claim 22 recites similar limitations regarding

the contrast agent and the volumetric composite image. Applicant agrees with the Examiner that Ogawa does not disclose or suggest a contrast agent.

According to page 3 of the Office Action, Hughes discloses using contrast agent, and both Ogawa and Hughes are both allegedly related to a similar methodology of imaging, and therefore, it would have been allegedly obvious to inter-relate teachings of different references. However, Applicant respectfully notes that just because Ogawa and Hughes are related to imaging, that alone cannot sustain a prima facie case of a § 103 rejection. In addition, just because different elements in a claim can be found in different references, that alone also cannot sustain a § 103 rejection. Rather, there must be some motivation for one skilled in that art to combine the references in the purported manner. For at least the foregoing reasons, Applicant respectfully requests that the § 103 rejection be withdrawn.

Also, according to the Office Action, Hughes discloses contrast agent, and it would have been allegedly obvious to incorporate the contrast agent of Hughes into the system and method of Ogawa “in order to create a high fidelity picture of the entire circulatory tree” (p. 5 of Office Action). However, there is nothing in the record indicating that the system of Ogawa has any need to create “high fidelity picture of the entire circulatory tree.” Thus, there is no reason to, and one skilled in the art would not, combine the contrast feature of Hughes with the method of Ogawa in the manner purported in the Office Action. Applicant notes that the above argument has not been considered in the Office Action. Thus, to the extent that the Examiner is inclined to maintain the § 103 rejection, Applicant respectfully requests that the Examiner provides some support to indicate why one skilled in the art who is concerned with eliminating bone images would also be interested in creating “a high fidelity picture of the entire circulatory tree,” so that Applicant can evaluate the basis of the rejection.

Also, Applicant notes that Ogawa and Hughes address completely different problems using different respective techniques. Ogawa is concerned with eliminating bone images to highlight soft tissue (column 7, lines 41-43), which according to the teaching of Ogawa, is achieved by a specific three-dimensional imaging procedure (column 7, lines 33-45, and column 8, lines 1-65) without any use of contrast agent. On the other hand, Hughes teaches how to highlight blood vessel using contrast agent in a two-dimensional x-ray imaging procedure (abstract). As such, even in view of both of the teachings of Ogawa and Hughes, there is no

reason to selectively take the contrast feature from Hughes and insert it into the method of Ogawa.

In addition, Applicant respectfully notes that Hughes teaches determining a 2-D contrast image (not a volumetric image) of the body structure (Col. 4, Lines 49-54). Thus, the purported combination would at most result in one of the 2-D projection images of Ogawa being a 2-D contrast image, and would not result in a volumetric composite image (resulted from two sets of contrast images with different respective energies). Applicant notes that this argument has not been considered in the Office Action. Thus, to the extent that the Examiner is inclined to maintain the § 103 rejection, Applicant respectfully requests that the Examiner indicate where Hughes discloses using contrast to obtain two sets of contrast images, and determining a volumetric composite image using these two sets of contrast images, so that Applicant can evaluate the basis of the rejection.

For at least the foregoing reasons, claims 1 and 22, and their respective dependent claims, are believed allowable over Ogawa, Hughes, and their combination.

Claims 1, 6-10, 14, 17, 19-21, 29, 32-37, 39-40, 43, 45-47, 56-57, 60-68, 70, and 72 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ogawa in view Acharya (U.S. Patent No. 6,922,462).

Claim 1 recites introducing a *contrast agent* into the body, generating a first set of image data using radiation at a first energy level after the contrast agent is introduced into the body, generating a second set of image data using radiation at a second energy level after the contrast agent is introduced into the body, and creating a *volumetric composite image* using the first and the second sets of image data (Emphasis Added). Claim 22 recites similar limitations regarding the contrast agent and the volumetric composite image. Applicant agrees with the Examiner that Ogawa does not disclose or suggest a contrast agent.

According to the Office Action, Acharya discloses contrast agent, and it would have been allegedly obvious to incorporate the contrast of Acharya into the system and method of Ogawa “in order to view and analyze the soft tissue portion of non-calcified plaque” (p. 7 of Office Action). However, Applicant respectfully notes that there is nothing in the record indicating that the system of Ogawa has any need to characterize plaque. Thus, there is no reason to, and one skilled in the art would not, incorporate the contrast feature of Acharya into the method of

Ogawa. As discussed just because two references are in the field of imaging, that alone cannot sustain a § 103 rejection. In addition, Applicant notes that just because different elements in a claim can be found in different references, that alone cannot sustain a § 103 rejection.

Also, Applicant notes that Ogawa and Acharya address completely different problems using different respective techniques. Ogawa is concerned with eliminating bone images to highlight soft tissue (column 7, lines 41-43), which according to the teaching of Ogawa, is achieved without any use of contrast agent. On the other hand, Acharya teaches how to characterize plaque using contrast agent (title and abstract). As such, even in view of both of the teachings of Ogawa and Acharya, there is no reason to selectively take the contrast feature from Acharya and insert it into the method of Ogawa.

For at least the foregoing reasons, claims 1 and 22, and their respective dependent claims, are believed allowable over Ogawa, Acharya, and their combination.

CONCLUSION

If the Examiner has any questions or comments regarding this amendment, please contact the undersigned at the number listed below.

To the extent that any arguments and disclaimers were presented to distinguish prior art, or for other reasons substantially related to patentability, during the prosecution of any and all parent and related application(s)/patent(s), Applicant(s) hereby explicitly retracts and rescinds any and all such arguments and disclaimers, and respectfully requests that the Examiner re-visit the prior art that such arguments and disclaimers were made to avoid.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Vista IP Law Group's Deposit Account No. **50-1105**, referencing billing number **VM 03-029 US**. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Vista IP Law Group's Deposit Account No. **50-1105**, referencing billing number **VM 03-029 US**.

Respectfully submitted,

DATE: March 6, 2009

By: /Gerald Chan/
Gerald Chan
Registration No. 51,541

VISTA IP LAW GROUP, LLP
1885 Lundy Ave., Suite 108
San Jose, California 95131
Telephone: (408) 321-8663 (Ext. 203)
Facsimile: (408) 877-1662